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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/863,342	05/23/2001	Geoffrey D. Alexander	RSW9-2001-0094-US1	1143

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Esther H. Chong, Esquire
Synnestvedt & Lechner LLP
2600 Aramark Tower
1101 Market Street
Philadelphia, PA 19107-2950

EXAMINER

HAQ, NAEEM U

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 06/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/863,342

Applicant(s)

ALEXANDER, GEOFFREY D.

Examiner

Naeem Haq

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 14 recite the conditional statement "...if the optimal shopping order exists." This conditional statement renders the claims indefinite since it is unclear to the Examiner what the scope of the claims is when the conditional statement is false. For examination purposes, the Examiner will take the broadest reasonable interpretation of the claims and assume that the conditional statement is false since nothing in the Applicant's specification precludes the conditional statements from being false. Therefore, the limitation containing the conditional statement will not be considered in the analysis of the claim. Likewise, claims 8, 21, and 22 also recite a conditional statement and a similar analysis holds for these claims as well.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6, 7, 14, 19, 20, 27, 32, and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman et al. (US 5,960,411).

Referring to claim 1, 6, 7, 14, 19, 20, 27, 32, and 33, Hartman teaches a method, system and computer program for providing online comparison shopping by a website system accessible by a user through a communication network, the method comprising the steps of: compiling a shopping list identifying specific items to be purchased (Figure 1C, items '106' and '107'); optimizing, by the website system, the shopping list to produce an optimal shopping order (column 5, lines 27-55). Hartman does not teach receiving optimization criteria specified by the user. However, Hartman teaches providing a user with a "shipping method" (Figure 1C, item '108'). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to allow the user to select a different shipping method such as express mail or overnight mail in the method, system and program of Hartman. One of ordinary skill in the art would have been motivated to do so in order to allow the user to speed up delivery of the product. Hartman does not teach that the optimizing is based on the optimization criteria specified by the user. However, Hartman teaches optimizing based on shipping. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to perform the optimization based on the user-specified shipping method. One of ordinary skill in the art would have been motivated to do so in order to be more responsive to the needs of the customer.

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Claims 2, 3, 4, 5, 10-13, 15-18, 23-26, 28-31, and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hartman et al. (US 5,960,411) in view of Official Notice.

Referring to claims 2, 4, 5, 13, 15, 17, 18, 26, 28, 30, 31, and 37, Hartman does not teach receiving the user's modifications to the optimal shopping order; re-optimizing the shopping list based on the modifications to produce an updated optimal shopping order; and displaying the updated optimal shopping order to the user. However, Official Notice is taken that it is old and well known in the art to allow a user to perform "what if" scenarios in order to seek a desirable outcome. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the method, system and program of Hartman. One of ordinary skill in the art would have been motivated to do so in order to allow a user to develop various scenarios from which to choose the most favorable.

Referring to claims 3, 16, and 29, Hartman does not teach receiving an acceptance of the optimal shopping order from the user; and processing the optimal shopping order in response to the receipt of the acceptance from the user. However, Official Notice is taken that it is old and well known in the art to process an order based on input from a user. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to do so in the invention of Hartman. One of ordinary skill in the art would have been motivated to do so in order to be more responsive to a customer.

Referring to claims 10 and 23, Hartman does not teach that the optimizing step is performed off-line; or notifying the user with a notification message when the off-line optimizing step is completed. However, Official Notice is taken that it is old and well known in the art to perform processing off-line and to provide a notification message when the processing is completed. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate these features into the invention of Hartman. One of ordinary skill in the art would have been motivated to do so in order to avoid excessive on-line charges.

Referring to claims 11 and 24, Hartman does not teach that the notification message is communicated to the user using e-mail. However, Official Notice is taken that it is old and well known in the art to use email notification messages. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate email notifications into the invention of Hartman. One of ordinary skill in the art would have been motivated to do so in order to use a well-known and widely available communication tool for sending notifications.

Referring to claims 12 and 25, Hartman does not teach that the notification message includes a unique identifier to be used by the user to access the optimal shopping order through the website system. However, the use of a URL link in a notification message is old and well known. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate an embedded URL link in a notification message in the invention of Hartman. One of

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ordinary skill in the art would have been motivated to do so in order to allow a user to access information by clicking on a link rather than by typing a long URL.

Referring to claims 35 and 36, Hartman does not teach notifying the user when its shopping order optimization process fails, or repeating shopping order optimization process until an optimal shopping order is produced, and notifying the user when the optimization process produces the optimal shopping order. However, Official Notice is taken that it is old and well known in the art for a program to provide error recovery in the event the program fails to process data properly. Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate this feature into the invention of Hartman. One of ordinary skill in the art would have been motivated to do so in order to provide a user-friendly way of handling processing failure.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (703)-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

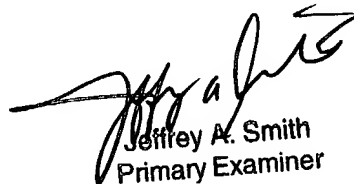
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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naeem Haq, Patent Examiner
Art Unit 3625

May 31, 2004



Jeffrey A. Smith
Primary Examiner